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H.H.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/214,971 01/15/99 VALENTE

G 30966.13USWO

IM52/0607  
OFFENHEIMER WOLFE & DONNELLY LLP  
2029 CENTURY PARK EAST  
38TH FLOOR  
LOS ANGELES CA 90067-3024

EXAMINER

CHEVALIER, A

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 06/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/214,971

Applicant(s)

VALENTE, GABRIELE

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001 and 13 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5-23 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 10-12, 15-17, and 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 9, 13, 14, 18, and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers.

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## **RESPONSE TO AMENDMENT**

### ***Continued Prosecution Application***

1. The request filed on November 13, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/214,971 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Election/Restrictions***

2. Applicant's election with traverse of Group II, claims 8, 9, 13, 14, 18, and 19 in Paper No. 14 is acknowledged. The traversal is on the ground(s) that it will be necessary to search both groups to effectively search the technology of the present. This is not found persuasive because the examiner has established that the inventions are distinct because they have separate status in the art as shown by their different classification, the search for Group I is not required for Group II, and they have recognized divergent subject matter.

The requirement is still deemed proper and is therefore made FINAL.

### ***WITHDRAWN REJECTIONS***

3. The 35 U.S.C. §112 rejections of record in paper #5, pages 3-4, paragraph #5 have been withdrawn due to Applicant's amendment in paper # 7.

4. The 35 U.S.C. §101 rejection of claims 8-9, 13-14, and 18-19 of record in paper #5, pages 4-5, paragraph #6 have been withdrawn due to Applicant's amendment in paper # 7.

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5. The 35 U.S.C. §102 rejections of record in paper #5, page 6, paragraphs #8 and 9 have been withdrawn due to Applicant's amendment in paper # 7.

6. The 35 U.S.C. §103 rejection of record in paper #5, page 6, paragraph #10 have been withdrawn due to Applicant's amendment in paper # 7.

***NEW REJECTIONS***

7. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 112***

8. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "regenerated leather regenerated material" in claim 8 is unclear which renders the claims vague and indefinite. It is believed that the second "regenerated" is a typographical error, which was supposed to be deleted as it was in claims 13 and 18.

***Claim Rejections - 35 USC § 103***

9. Claims 8, 9, 13,14, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (3,741,844) in view of Taylor (3,971,839).

Schwartz discloses a hot melt process for forming a resin layer on a polyurethane foam for use as furnishing elements such as cushions (col. 1, lines 1-5). The invention of Schwartz

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comprises a polyurethane foam substrate coated with a film or sheet of polyolefin (col. 3, lines 39-42). The polyolefin film is an embossed polyethylene film (col. 4, lines 11-13). The polyolefin film is added to the substrate to prevent moisture of liquid from entering the substrate and to produce a lower coefficient of friction (col. 3, lines 4-19).

Schwartz also discloses that this type of extrusion coating is known to be used with other substrates such as leather (col. 5, lines 25-32).

Schwartz generally discloses the instant claimed invention except for the steps of forming the material into a cushion including a step of cutting the composite material to form the product.

Taylor discloses a method of making a cushion made of leather that includes cutting the composite material. See whole document.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a cushion using the method of Taylor with the material of Schwartz because of the improved friction coefficient of friction and resistance to moisture and liquid obtained by the polyethylene layer.

10. Claims 8, 9, 13, 14, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irion (2,714,571) in view of Holtzman (3,866,554) or Lockwood (3,641,603).

Irion discloses bonding an embossed polyethylene film to a fibrous web for use in manufacturing of very inexpensive and sturdy artificial leathers, furniture and surfacings, luggage coverings and similar materials (col. 1, lines 55-60). The polyethylene layer is a well recognized protective coating material. It has low moisture-vapor permeability, it is tough, extensible, and abrasive resistant, it has high tear strength, it is odorless, tasteless, and non-toxic,

it can be formed or shaped by thermal means without additives and has a low specific gravity so that a given thickness will cover a relatively large area per pound (col. 1, lines 11-21).

Irion generally discloses the instant claimed invention except for the substrate is leather and the steps of forming the material into a piece of luggage or shoe including a step of cutting the composite material to form the product.

Holtzman discloses a method of making luggage made of leather that includes cutting the composite material. See whole document.

Lockwood discloses a method of making a shoe made of artificial or real leather that includes cutting the composite material. See whole document.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a leather substrate, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. One of ordinary skill in the art would have been motivated to use leather because it is a very popular material for luggage or shoes. Also, one of ordinary skill would be motivated to add a layer of embossed polyethylene to a leather substrate because of the improved protective properties obtained by the embossed polyethylene layer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make luggage using the method of Holtzman or make shoes using the method of Lockwood with the material of Irion because of the improved properties of the material obtained by the polyethylene layer.

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***ANSWERS TO APPLICANT'S ARGUMENTS***

11. Applicant's arguments filed in paper #7 regarding the 35 U.S.C. §112, §101, §102, and §103 rejections of record have been considered but are moot since the rejections have been withdrawn.

***Conclusion***

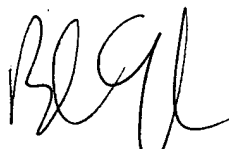
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Blaine Copenheaver can be reached by dialing (703) 308-1261. The fax phone number for the organization official non-final papers is (703) 305-5436. The fax number for after final papers is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

06/06/01

  
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